

## REMARKS

Applicants intend this response to be a complete response to the Examiner's **20 September 2005 Final Office Action**. Applicants have labeled the paragraphs in his response to correspond to the paragraph labeling in the Office Action for the convenience of the Examiner.

### *Claim Rejections - 35 USC § 112*

2. **Claims 2-9, 14-16 and 25-38** stand rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling.

The Examiner contends as follows:

The method without extraction and separation steps, which are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The contacting step alone would not produce a clean material. The contacting step would only produce a mixture of the fluid, the material, and contaminants. The essential steps needed to produce a clean material are not included in the claims.

Applicants have canceled claims 14-16 and claims 25-38 and have amended claims 2-9 to depend from new claim 39. As the Applicants understand from the rejection, claim 25 only had section 112 rejections. Applicants have added new claim 39 which is a combination of claim 38 and 25. This claim includes all the steps that are required for treating a material and producing three different products: a solids product, an aqueous product and a non-aqueous product. Applicant believes that new claims 39 removes all the section 112 rejections and because no 102/103 rejections were leveled against claim 25, Applicants believe that this claim is allowable and that claims 2-9 are also allowable as depending from claim 39.

3. **Claims 25 and 14-16** stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

The Examiner contends as follows:

The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims are not enabled because they require removal of water and water soluble components to produce an aqueous product. Removal of water would produce non-aqueous product.

Applicants have canceled claim s 14-16 and claim 25 and have added new claim 39. New

claims 39 describes a process by which the aqueous components in the material-to-be-treated are removed from the treating vessels via a semi-permeable membrane to produce a aqueous product that comprises water and the water soluble components that pass through the semi-permeable membrane. The product separation process is fully described in the specification. The reactor set forth in the specification produces three products: a cleaned hydrocarbon or non-aqueous product, an aqueous product and a solids product. Applicants believe that one of ordinary skill in the art would understand this from the terms of claim 39 as those terms are read in light of the specification. Clearly, many material that one desires to clean include aqueous components (water and water solubles), non-aqueous (e.g., hydrocarbons, silicones, etc.) and solids. This process separates the material into three components: an aqueous product that is removed from the material via the semi-permeable membrane, a non-aqueous material that is removed from the solids along with the extracting fluid and a solids product. Applicants see nothing in the claims that is ambiguous or inconsistent. Clearly, when the water and water solubles pass through the material in the extraction zone becomes non-aqueous, but that does not mean that an aqueous product is not being removed.

4. **Claims 5-9, 14-16 and 25-37** stand rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for specific products, does not reasonably provide enablement for any non-specified composition comprising non-specified products.

The Examiner contends as follows:

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

Applicants have canceled claims 14-16 and 25-27 and amended claim 5-9 to depend ultimately on new claim 39 mooted this rejection.

6. **Claims 5-9, 14-16 and 25** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner contends as follows:

Claims 5-9 and 26-37 are indefinite because the terms "the solids product", "the non aqueous fluid product", "the aqueous product", etc. lack proper antecedent

basis. It is absolutely not clear what is referenced as these "products".

Claim 25 is indefinite because the terms "the treated material", "the solids", "the fluid", "the extraction fluid" lack proper antecedent basis.

The claim is also indefinite because it is not clear from the claim concurrently with what the water should be removed.

Claims 14-16 are indefinite because of the deficiencies of claim 25.

Applicants have canceled claims 14-16 and 25-27 and amended claim 5-9 to depend ultimately on new claim 39 mooted this rejection.

### ***Response to Amendment***

7. The Examiner contends as follows:

It is noted, that claim 3 now recites "CO" in line 2, instead "CO<sub>2</sub>". The applicants have not indicated this change as amendment. Such amendment is not supported by the specification. It is reasonably believed that the change is due to a typing mistake. The claim is interpreted accordingly as reciting CO<sub>2</sub>. However, clarification is requested.

However, if the applicants indeed intended to amend the claim to recite CO, the claim should be considered as rejected under 35 USC 112 (1) as not supported by the original disclosure and the amendment should be considered as objected as introducing new matter to the disclosure and should be canceled.

Applicants have corrected claim 3 to read CO<sub>2</sub>, which was simply a typographical error.

### ***Election/Restrictions***

9. The Examiner contends as follows:

The product-by-process claims presented now are indefinite and their scope is unclear. These claims were interpreted to the best examiner's understanding of what is claimed. It is noted that when the referenced claims be placed in correspondence with requirements 35 USC 112 a restriction and/or election requirement could be issued by the examiner.

Applicants have canceled all product-by-process claims.

### ***Claim Rejections - 35 USC § 102***

11. Claims 38, 2 and 4-9 stand rejected under 35 U.S.C. 102(b) as being anticipated by the publication of Critical Fluid Systems Inc. (CFSI).

The Examiner contends as follows:

The CFSI teaches a method as claimed. See entire document, especially the

part Critical Fluid Extraction.

Since the CFSI discloses the same manipulative steps as claimed the results recited by claim 7, and products recited 14-16 are inherently disclosed.

Applicants have canceled claim 38 and have amended claims 2-9 to depend from new claim 39. As the Applicants understand from the rejection, claim 25 only had section 112 rejections. Applicants have added new claim 39 which is a combination of claim 38 and 25. This claim includes all the steps that are required for treating a material and producing three different products: a solids product, an aqueous product and a non-aqueous product. Applicant believes that new claims 39 removes all the section 112 rejections and because no 102/103 rejections were leveled against claim 25, Applicants believe that this claim is allowable and that claims 2-9 are also allowable as depending from claim 39.

**12. Claims 14, 26, 29, 32, 35** stand rejected under 35 U.S.C. 102(b) as being anticipated by soil.

The Examiner contends as follows:

The claims recite a composition comprising non-specified solids, solids substantially free from hydrocarbons and contaminants or soil. Any non-contaminated soil meets the recited limitations.

**Applicants have canceled claims 14, 26, 29, 32, 35 rendering this rejection moot.**

**13. Claims 15, 27, 30, 33, and 36** stand rejected under 35 U.S.C. 102(b) as being anticipated by oil.

The Examiner contends as follows:

Oil meets the recited limitations.

**Applicants have canceled claims 15, 27, 30, 33, and 36 rendering this rejection moot.**

**14. Claims 16, 28, 31, 34, and 37** are rejected under 35 U.S.C. 102(b) as being anticipated by water.

The Examiner contends as follows:

Water meets the recited limitations.

Applicants have canceled claims 16, 28, 31, 34, and 37 rendering this rejection moot.

*Claim Rejections - 35 USC § 103*

17. **Claims 3** stands rejected under 35 U.S.C. 103(a) as being unpatentable over the publication of Critical Fluid Systems Inc. (CFSI).

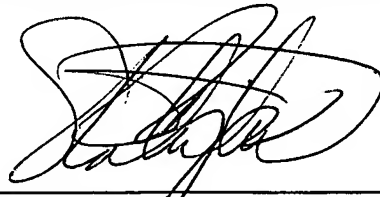
The Examiner contends as follows:

The CFSI teaches the claimed method except for the use of a mixture of carbon dioxide with other disclosed fluids. However, it would have been obvious to an ordinary artisan at the time the invention was made to use a mixture of the disclosed fluids with reasonable expectation of adequate results in order to more completely remove contaminants using different solubility properties of the different fluids.

Applicants have amended claims 3 to depend from new claim 39. As the Applicants understand from the rejection, claim 25 only had section 112 rejections. Applicants have added new claim 39 which is a combination of claim 38 and 25. This claim includes all the steps that are required for treating a material and producing three different products: a solids product, an aqueous product and a non-aqueous product. Applicant believes that new claims 39 removes all the section 112 rejections and because no 102/103 rejections were leveled against claim 25, Applicants believe that this claim is allowable and that claims 2-9 are also allowable as depending from claim 39.

Having fully responded to the Examiner's Non-Final Office Action, Applicant respectfully urges that is application be passed onto allowance. If it would be of assistance in resolving any issues in this application, the Examiner is kindly invited to contact applicant's attorney Robert W. Strozier at 713.977.7000.

Date: 17 January 2006



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